

Application No. 10/614,116
Office Action dated January 13, 2006
Reply dated March 13, 2006

REMARKS

Claims 1-18 are pending in this application. The examiner acknowledged applicants' election of Group IV, claims 6-12, in the reply filed October 19, 2005. However, the examiner noted that applicants must elect a compound of formula I, II or III. The examiner suggests that this Application contains the following inventions or groups of inventions:

Group I, claims 1-5, drawn to a compound of formula I;

Group II, claim 1, drawn to a compound of formula II;

Group III, claims 1-5, drawn to a compound of formula III;

Group IV, claims 6-12, drawn to a method of modulating expression of a target gene using compound of formula I, II and III;

Group V., claim 13, drawn to a method of producing polypeptide in a cell using compound of formula I, II and III;

Group VI, claims 14-17, drawn to a method of regulating endogenous or heterologous gene expression using compound of formula I, II and III; and.

Group VIII, claim 18, drawn to a method of modulating a gene in a host using compound of formula I, II and III.

The examiner suggests that the inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features for the following reasons: common utility and sharing a substantial structural feature disclosed as being essential to the utility. Specifically the examiner stated that Groups I-III relate to compounds, Groups IV-VII relate to various methods of uses, and Groups I, II and III are independent and distinct from each other as they are directed to structurally dissimilar compounds that lack a common core.

In reply, and solely to be responsive to the examiner's requirement, Applicants provisionally elect Group IV, claims 6-12, drawn to a method of modulating expression of a target gene using compound of formula I, with traverse.

Under Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must

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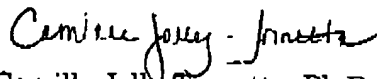
examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

The methods of Groups IV-VII all relate to the use of the compounds as ligands of a specific inducible gene expression system. Accordingly examination of the methods of Groups IV-VII involves a fundamental determination of the novelty of compounds as ligands for this specific inducible gene expression system. To the extent that this determination would be made, it is submitted that a preponderantly coextensive search would result. In particular, an exhaustive search for the use of the compounds of the present invention as ligands for an inducible gene expression system would encompass the methods of claims 6-18 (Groups IV-VII).

Thus, Applicants submit that the search and examination of the methods, Groups IV-VII of the present application can be made without serious burden. Applicants respectfully submit that conjoint examination and inclusion of all of the method claims of the present application would not present an undue burden on the examiner, and accordingly, withdrawal of this restriction is believed to be in order.

In the event that the restriction is maintained, Applicants reserve the right to file divisional applications directed to the subject matter of the non-elected claims of Groups I, II, III, V, VI and VII. If a telephone interview would be of assistance in advancing prosecution of this application, Applicants' agent invites the examiner to contact her at (610) 650-8734 ext. 104.

Respectfully submitted,


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